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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/579,324	05/25/2000	Thomas Nello Giaccherini	HDM2000-1	7267

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EXAMINER	
LY, ANH VU H	
ART UNIT	**PAPER NUMBER**
2667	6

DATE MAILED: 10/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/579,324	GIACCHERINI ET AL.	
	Examiner	Art Unit	
	Anh-Vu H Ly	2667	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-24 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-24 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4-5 .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Claim Objections

1. Claims 3-7 and 18-19 are objected to because of the following informalities:

With respect to claims 3-7, a single satellite is claimed in dependent claim 2. However, in claims 3-7, which depend upon claim 2, "said satellites" is claimed.

Claim 5 is objected for the typographical error "**hgih**" recited in line 1.

Claims 3 and 7 are objected for claiming similar subject matter.

Claims 18 and 19 are objected for claiming similar subject matter.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 11-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claim 11, in line 7, "said satellite means" lacks antecedent basis.

Claims 12-24 are rejected as they depend upon rejected independent claim 11.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1-2, 8-20, and 23-24 are rejected under 35 U.S.C. 102(e) as being anticipated by Picco et al (US Patent No. 6,029,045). Hereinafter, referred to as Picco.

With respect to claim 1, Picco discloses (col. 9, lines 1-7 and Fig. 6) that the private data may be downloaded to each set-top box by a trickle, i.e., background, download technique, a nightly download technique or a dual receiver technique. The trickle technique takes advantage of the fact that the entire bandwidth of the satellite is not utilized at all times and the unused bandwidth may be used to download the private data and local content (utilizing the excess capacity of a network by conveying data over said network during a period of less than maximum usage).

Picco discloses (col. 9, lines 40-48) that the local content is downloaded (receiving data during period of less than maximum usage) to the set-top box in the background and then a particular piece of local content may be used (retrieving data for on-demand use at a time after

extended period of time) once the entire piece of local content resides on a memory or a disk (accumulating data over an extended period of time) in the set-top box.

With respect to claims 2 and 14, Picco discloses in Fig. 3, a satellite communications system for downloading private data and local content to the set-top box (the network includes a satellite).

With respect to claims 8, 15, 23, and 24, Picco discloses in Fig. 3, a satellite communications system (the network includes a sub-orbital platform).

With respect to claims 9 and 16, Picco discloses in Fig. 3, live feeds and added contents are wired to the uplink 102 for transmissions (the network includes a terrestrial wired network).

With respect to claims 10 and 17, Picco discloses in Fig. 3, a satellite communications system (the network includes a terrestrial wireless network).

With respect to claim 11, Picco discloses in Fig. 3, the uplink 102 for transmitting private data and local content to the set-top box 120 (a gateway means for transmitting a plurality of digitized packets of data). Further, as shown in Fig. 3, satellite 104 is used to relay the digitized packets of data received from the uplink 102 (a relay means for receiving plurality of digitized packets of data from the gateway means). Picco discloses (col. 9, lines 1-7 and Fig. 6) that the private data may be downloaded to each set-top box by a trickle, i.e., background, download

technique, a nightly download technique or a dual receiver technique. The trickle technique takes advantage of the fact that the entire bandwidth of the satellite is not utilized at all times and the unused bandwidth may be used to download the private data and local content (retransmitting during a time period when the total communications capacity of the relay means is not fully used)

Picco discloses (col. 9, lines 40-48) that the local content is downloaded (receiving means for collecting plurality of digitized packets of data which are transmitted from the satellite means) to the set-top box in the background and then a particular piece of local content may be used (retrieving and using plurality of digitized packets of data after a generally full program has been accumulated) once the entire piece of local content resides on a memory or a disk (receiver means including a storage means for accumulating plurality of digitized packets of data incrementally over an extended period of time) in the set-top box.

With respect to claim 12, Picco discloses in Fig. 3, a set-top box for downloading, retrieving, and displaying data, wherein, such set-top box is already shielded by the manufacturer for protecting radio frequency interference (receiver means is shielded to eliminate local radio frequency transmissions that could be used to make an unauthorized copy).

With respect to claim 13, Picco discloses in Fig. 3, a shielded set-top box for downloading, retrieving, and displaying data of a registered subscriber (receiver means is tamper-proofed to thwart unauthorized copying).

With respect to claims 18 and 19, Picco discloses in Fig. 3, the set-top box is located in a house (receiver means is located on the Earth's surface).

With respect to claim 20, Picco discloses in Fig. 3 that the receiver is fixed (receiver means is located in a fixed terminal).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 3-7 and 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Picco et al (US Patent No. 6,029,045).

With respect to claims 3 and 7, Picco discloses in Fig. 3, a satellite communications system for downloading private data and local content to the set-top box. Picco does not disclose such satellites operate in low Earth orbit. However, satellites operating in LEO, MEO, and GEO, are known in the art. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to operate the satellites in LEO in Picco's system, since LEO requires less power to operate and short delays comparing to MEO or GEO.

With respect to claim 4, Picco discloses in Fig. 3, a satellite communications system for downloading private data and local content to the set-top box. Picco does not disclose such

satellites operate in medium Earth orbit. However, satellites operating in LEO, MEO, and GEO, are known in the art. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to operate the satellites in MEO in Picco's system, since MEO requires less power to operate and short delays comparing to GEO.

With respect to claims 5 and 6, Picco discloses in Fig. 3, a satellite communications system for downloading private data and local content to the set-top box. Picco does not disclose such satellites operate in high Earth orbit or geo-synchronous Earth orbit. However, satellites operating in LEO, MEO, HEO and GEO, are known in the art. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to operate the satellites in HEO and GEO in Picco's system, since HEO and GEO requires less satellites to cover the wider range.

With respect to claims 21 and 22, Picco discloses in Fig. 3, the receiver means is located within the set-top box. Picco does not disclose the receiver means is located in a portable terminal or a mobile terminal. However, it is known in the art that a portable terminal or a mobile terminal is capable of receiving data from base stations or satellites such as cell phones or handheld devices. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include the receiver means in the portable terminal or in the mobile terminal in Picco's system, for downloading and displaying data such as text, graphics, etc...

Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

5. Claims 1-10 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-6 and 8-10 of copending Application No. 09/833094 (US Pub No. 2002/0042919 A1). This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claim 11 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 20 of copending Application No. 09/833094 (US Pub No. 2002/0042919 A1). Although the conflicting claims are not identical,

they are not patentably distinct from each other because claim 11 of the examined application and claim 20 of the copending application recite an apparatus comprising a gateway means for transmitting digitized packets, a relay means for receiving digitized packets, a receiver means for collecting and accumulating digitized packets and retrieving and using the digitized packets after a full program has been accumulated.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Dillon et al (US Patent No. 5,652,795) discloses method and apparatus for an adapter card providing conditional access in a communication system.

Montpetit (US Patent No. 6,366,761) discloses priority-based bandwidth allocation in a LEO satellite data communication network.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anh-Vu H Ly whose telephone number is 703-306-5675. The examiner can normally be reached on Monday-Friday 7:00am - 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chi Pham can be reached on 703-305-4378. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4750.

avl

CHI PHAM
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600 9/25/03